

## REMARKS

The Examiner has objected to Claims 1, 2, and 17 because of the phrase "opening or openable portion". The Applicant appreciates the wisdom of Examiner's suggestion to amend that phrase to "exposed portion," and has therefore amended the Claims according to the Examiner's suggestion.

Next, the Examiner has rejected claims 1-9, 11, 12, 13, and 15-17 pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Owens et al., U.S. Pat. No. 5,256,131, ("Owens et al."), in view of Nielsen et al., U.S. Pat. No. 5,791,608, ("Nielsen et al."). The Examiner has specifically alleged that Owens et al. show an elongated element wrapped around the periphery of an item leaving the portion of the item exposed and that the elongated element is held by hook and loop fasteners. The Examiner goes on to allege that Nielsen et al. disclose a wrap style type of holder having hook and loop fasteners and a magnet means self covered to prevent damages to metal finishes. The Examiner concludes that "it would have been obvious to one skilled in the art at the time the invention was made to have provided the device shown by Owens et al. with magnetic means as shown by Nielsen et al. to secure the holder against a magnetic surface." *See Official Action mailed April 28, 200, para. 4.* Applicant respectfully traverses the rejection.

To begin, Owens et al. recite a clear object, which is to "reduce the number of pieces of material that are needed in manufacturing a beverage cooling or warming wrap." *See Owens et al.*, Col. 1, lines 62-64. This, the Applicant submits, is a clear teaching away from the claimed invention, which clearly would **add** to the number of pieces in the beverage wrap of Owens et al. by **adding** a magnet to it. For this reason alone, Owens et al. cannot be the proper basis for an obviousness rejection because teaching away from the art is a *per se* demonstration of lack of *prima facie* obviousness. In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

To continue, it is a well-settled principle in the law that prior art is insufficient to form a basis for establishing unpatentability unless the art also contains some teaching, suggestion, or incentive to look to particular sources of information, to select particular elements, and to combine them to arrive at the claimed invention. *See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931 (Fed. Cir. 1990). If it even exists, that teaching, suggestion, or incentive must motivate the skilled artisan to combine the teachings or suggestions with a *reasonable expectation of success*. Further, it is very important that the teaching or suggestion to make the claimed combination and the reasonable expectation of success be apparent from the prior art, and not the applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.03. It therefore is improper for the Examiner to use the applicant's invention as a blueprint to hunt through the prior art for the claimed elements and then combine them as claimed. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997).

Applicant respectfully submits that there is no teaching, suggestion, or motivation in Owens et al. to combine its teachings with that of Nielsen et al., let alone to combine them with any reasonable expectation of success. Owens et al. is directed to an improved method of manufacturing a beverage cooling or warming wrap that contains a layer of insulation, a channel for holding a chillable or warmable blanket, and fasteners for fastening the wrap around a beverage container that is to be kept cool or warm. *See Owens et al.*, Col. 1, lines 5-14. Owen et al. discloses at length, and in considerable detail, a process by which a cooling or warming wrap is made. Some of the details of that process include placing a hem **15** in one end of the fabric **14** with the tag of the hem **15** facing up. *See Owens et al.*, Col. 2 line 68 to Col. 3, line 1. Another detail of the process includes superimposing an insulating material **16** on a side of the fabric **14** so that the insulation is near the unhemmed end **17** of the fabric. *See Owens et al.*, lines 5-8.

Owens et al. go on to disclose other intricacies of the process which include folding the fabric twice lengthwise to form a three-layered bundle 24 and securing said bundle along the longitudinal edges thereof. Without going into further detail of what Owens et al. actually disclose, suffice it to say that Owens et al. do not in any way provide the skilled artisan with any teaching, suggestion, or incentive to look to Nielsen et al. to arrive at the claimed invention. This is because Owens et al. is only teaches how to make a better insulating wrap for beverages; Owens et al. does not teach, nor were its inventors remotely concerned with securing beverages to any surfaces, let alone magnetic surfaces. Thus, Owens et al. does not motivate the skilled artisan to look to Nielsen et al. for any such teaching. The Applicant respectfully submits that a detailed process for manufacturing a heating or cooling wrap, without any reference to any means of attaching the wrap to any surface (as in Owens et al.) is a highly unlikely place for skilled artisan to find the motivation, suggestion, or teaching to combine a wrap with a magnet contained in a paint brush holder (as disclosed by Nielsen et al.).

Respectfully, the only way the skilled artisan would combine the teaching of Owens et al. with that of Nielsen et al. would be to use the benefit of hindsight. And using hindsight in making an obviousness rejection is impermissible. Indeed, the only way the skilled artisan would arrive at the cited combination would be to use the claimed invention as a blueprint. *See In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). Because of this, the rejection of Claims 1-9, 11, 12, 13, and 15-17 as allegedly unpatentable over Owens et al. in view of Nielsen et al. is overcome, and withdrawal thereof is respectfully requested.

Additionally, Applicant respectfully submits that Nielsen et al. is nonanalogous prior art and therefore cannot be applied to support a rejection under 35 U.S.C. § 103. Binding Federal Circuit case law provides the Examiner with the relevant test for determining whether a

particular reference is appropriate and analogous. That test is to 1) determine whether the references is "within the field of the inventor's endeavor"; and 2) assuming the reference is outside that field, to determine whether the reference is "reasonably pertinent to the particular problem with which the inventor was involved." In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); see also In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). The Federal Court cautions that in determining the appropriateness of applying a reference, "prior art may not be gathered with the claimed invention in mind." Pentec, Inc. v Graphic Controls Corp., 776 F.2d 309, 227 USPQ 766 (Fed. Cir. 1985) ( again the Federal Circuit is indicating that using hindsight is impermissible).

Applying the first prong of the Federal Circuit's test, Nielsen et al. is nonanalogous art since it is not within the field of the inventors' endeavor. The field of the endeavor of the inventor if the claimed invention is clearly a holding apparatus for *liquid-containing devices*, and more particularly to cup holding devices that are capable of receiving a cup a mounting it on a magnetic surface. *See Specification, page 1, lines 4-6*. From reading the background section for the claimed invention, it is clear that Applicant was concerned with the field of cup holders. Applicant discloses various cup holders in the field of the inventors endeavor, for example, ones that "affix about the curvature of a cup," one that have a "fluted appearance," and ones that have been incorporated in to other structures to provide a fixed-in-place support, such as in a dashboard, door or center section of a motor vehicle, or in the armrest of a movie theater or stadium chair." Notably absent from this discussion is any reference to paint brush holders- such as that which is disclosed by Nielsen et al. As such, Nielsen et al. is directed to a field (paint brush holders) that is entirely outside of the inventor's endeavor, which is beverage holders.

With Nielsen et al. outside the field of the inventors' endeavor, the Federal Circuit directs the Examiner to the next inquiry, which is whether either reference is reasonably pertinent to the particular problem with which the inventors of claimed invention are involved – as will be shown, Nielsen et al. is not. To illustrate, the object of the claimed invention is to enhance a cup's insulation ability and to block condensation. Another clear objective of the claimed invention is to provide a cup holder having the capability of being supported by a metal magnetic accepting support or surface. It is a further object of the claimed invention that the holder be adaptable to accommodate a variety of liquid-containing devices such as, for example, different types and sizes of cups, mugs, bottles and cans. Another object of the claimed invention is to provide a wrap that insulates, magnetically attaches to any magnetic accepting surface while supporting a liquid-containing device. *See Specification, pages 2 and 3.* Thus, the pertinent problem facing Applicant was need to provide a holder that is adaptable to accommodate a liquid-containing device that could magnetically attach to any magnetic accepting surface.

Nielsen et al. is not directed to this problem. In contrast, Nielsen et al. is directed to problems that were quite different than those faced by the inventor of the present invention. As Nielsen et al. clearly disclose, one of the problems its inventors faced was inefficiency, "awkwardness," and expense of the paint brush holders at the time of the invention in Nielsen et al. *See Nielsen et al.*, Col. 1, lines 12-16. Nielsen et al. go on to disclose other problems that were pertinent to it such as the allowing a paint brush to hold its shape and allowing a brush to dry rapidly while in the holder. *See Nielsen et al.*, Col. 1, lines 28-30. To be sure, these are not the types of problems that faced the inventor of the claimed invention. Therefore, the inventor of the claimed invention could not be expected to look to Nielsen et al. for providing a teaching relevant to the *pertinent problems* before him. "A reference is reasonably *pertinent* if ... it is

one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering the problem." Wang Labs., Inc. v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993). Because of the widely divergent aims of Applicant with that of the inventors of Nielsen et al., Applicant respectfully submits that Nielsen et al. would not have "commended itself to [the] [Applicant's] attention in considering the problem ." Wang Labs, Inc., 933 F.2d 858. Accordingly, Nielsen et al. is nonanalogous art.


The Examiner has rejected Claims 10 and 14 under 35 U.S.C. 103(a) as allegedly unpatentable over Owens et al. in view of Nielsen et al. and Millis et al, U.S. Pat. No. 4,989,811("Millis et al."). The Applicant respectfully submits that any teaching in Millis et al. does not ameliorate the deficiencies of the Owens et al./Nielsen et al. combination. Accordingly, the Applicant rejects withdrawal of the rejections of Claims 10 and 14.

Applicant respectfully submits that the patent application and the claims, as amended, therein are in a condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested.

Applicant would appreciate the courtesy of a telephone call should the Examiner have any questions or comments with respect to this response or the claim language for purposes of efficiently resolving same.

Respectfully submitted,

By

  
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